

REMARKS

By this amendment, claims 1-5, 7-12, 14-17, and 19-24 have been cancelled, claim 18 has been amended. Accordingly, claim 18 is currently pending in the application and it is an independent claim.

Applicants respectfully submit that the above amendments do not add new matter to the application and are fully supported by the specification. Indeed, all of the present amendments are merely to clarify by correcting typographical errors in the previous version of the claims.

Entry of the Amendments and Remarks is respectfully requested because entry of Amendment places the present application in condition for allowance, or in the alternative, better form for appeal. No new matters are believed to be added by these Amendments. In view of the above amendments and the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Claim Comments

In the Office Action, Claims 2, 7, 9, 17-18, 20, and 22-24 commented on by the Examiner (p. 9, ¶ 13 of Office Action). Applicants thank the Examiner for noting these typographical errors.

Claim 18 has been amended to fix the typographical errors noted by the Examiner. This amendment is made for the sole purpose of correcting obvious typographical errors. This amendment is not made for the purpose of avoiding prior art, overcoming a rejection or objection, or narrowing the claimed invention, and no change in claim scope is intended. Therefore Applicants do not intend to relinquish any subject matter by this amendment.

Applicants respectfully submit that claim 18 as amended, no longer contain the identified typographical errors. Applicants respectfully note that the remainder of the claims have been cancelled. Thus, the comments by the Examiner with regard to the remaining claims are moot. Accordingly, Applicants believe that Examiner's comments should not be the basis for any future objection or rejection of these claims.

Rejections Under 35 U.S.C. §102

Claims 1-5 and 19-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2003/0134145 to Toguchi, *et al.* ("Toguchi"). Applicants respectfully traverse this rejection for at least the following reasons.

The Applicants observe that the present assignee is the same as the assignee of the alleged prior art. Applicants do not, therefore, disclaim any subject matter by their cancellation of these rejected claims. Applicants have cancelled these claims, and thus the rejection of these claims is moot.

Rejections Under 35 U.S.C. §103

Claims 1, 3-5, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,329,084 issued to Tamano, *et al.* ("Tamano") in view of no additional art. Applicants respectfully traverse this rejection for at least the following reasons.

The Applicants observe that the present assignee is the same as the assignee of the alleged prior art. Applicants do not, therefore, disclaim any subject matter by their cancellation

of these rejected claims. Applicants have cancelled these claims, and thus the rejection of these claims is moot.

Rejections Under 35 U.S.C. §103

Claims 1, 3-5, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 11-144869 in view of no other art. Applicants respectfully traverse this rejection for at least the following reasons.

The Applicants observe that the present assignee is the same as the assignee of the alleged prior art. Applicants do not, therefore, disclaim any subject matter by their cancellation of these rejected claims. Applicants have cancelled these claims, and thus the rejection of these claims is moot.

Rejections Under 35 U.S.C. §103

Claims 1-5, 7-12, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 11-185961 in view of no other art. Applicants respectfully traverse this rejection for at least the following reasons.

The Applicants observe that the present assignee is the same as the assignee of the alleged prior art. Applicants do not, therefore, disclaim any subject matter by their cancellation of these rejected claims. Applicants have cancelled these claims, and thus the rejection of these claims is moot.

Rejections Under 35 U.S.C. §103

Claims 1-3, 7-10, and 14-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 10-88120 (“*Okutsu*”) in view of no other art. Applicants respectfully traverse this rejection for at least the following reasons. Applicants have cancelled claims 1-3, 7-10, 14-17, and 19-24, and thus the rejection as applied to those claims is moot. Claim 18 is still pending, and should be allowed for the following reasons.

Applicants note that the Examiner incorporates referentially the reasons stated in the office action mailed June 9, 2003. Accordingly, Applicants thank the Examiner for again observing (this time by referential incorporation) that *Okutsu* is insufficient as an anticipatory reference because it does not contain every element of the claims. In particular, the Examiner has noted that *Okutsu* at least does not teach the specific compounds claimed.

As a preliminary matter, there is no cited reference to remedy the deficiencies of *Okutsu*. Instead, the Examiner relies on the Examiner’s own notions of what one of ordinary skill in the art would think. Indeed, the Examiner does not even assert that there is any teaching, suggestion, or motivation *in the art* to suggest the proposed modification which the Examiner alleges would read the claims. Instead, the Examiner relies on the unsupported assertion that to modify the structure of *Okutsu* would have been obvious because one would also expect modifications to have similar properties.

There are, however, several flaws in the Examiner’s argument. First, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present prosecution, the only teaching or suggestion to

make the claimed combination is in Applicants' disclosure. Accordingly, the rejection is improper.

Moreover, the rationale that the Examiner uses for modifying the reference is flawed.

The Examiner asserts that the reason to modify the reference is that similar structures will likely yield similar results. Assuming, *arguendum*, that this is both true and relevant, it is not a reason for making a change. One seeking to produce the results taught by the reference would use the specific compounds taught by that reference because those presumably *do* produce the results claimed by the reference's author. There is no motivation to change something that presumably works.

Additionally, the Examiner's implied assertion that the device taught in the reference is the same as the presently claimed invention is not based in the claim language. In particular, the reference apparently discusses the successive lamination of various layers. No such limitation is found in the claims of the present invention. Indeed, as indicated in the Summary of the Invention in the present application, "it is ... [a feature] of the present invention to provide an organic EL device[] ... by suppressing the concentration quenching." (p. 4, ll. 7-10). In contrast, the cited reference does not have any such object. Accordingly, one would certainly not have been motivated to modify the reference, and in particular to select a group having steric hindrance.

Moreover, the Examiner cites the reference, but does not provide any motivation to combine that reference with another that teaches the missing elements. Accordingly, as explained above, the cited reference does not render the claims obvious.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1-3, 7-10, and 14-24. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1, 7, 14, 18, 19, 20, and 21, and all the claims that depend from them are allowable.

Other Matters

Claims 1-5, 7-10, and 18-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over claims 1-17 of U.S. Patent No. 6,329,083 issued to Toguchi, *et al.* ("Toguchi") under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully traverse this rejection for at least the following reasons. Claims 1-5, 7-10, and 19-24 have been cancelled, and thus the rejection is moot as to those claims. Claim 18 is pending in this application.

At the outset, Applicants note that the Examiner incorporates referentially the reasons stated in the office action mailed June 9, 2003. Accordingly, Applicants thank the Examiner for again observing (this time by referential incorporation) that the allegedly conflicting claims are not identical. The Examiner, however, asserts that they are not patentably distinct. The Examiner appears to be asserting that there is a genus-species relationship between the claims of the cited reference and the claims of the present application. Applicants respectfully disagree that such a simplistic view is accurate.

Applicants respectfully suggest that a rejection requires an analysis of the claim language, not merely an assertion of a genus-species relationship.

Accordingly, Applicants expect that this rejection will be withdrawn. However, if it is not, Applicants may elect to file a terminal disclaimer to advance prosecution.

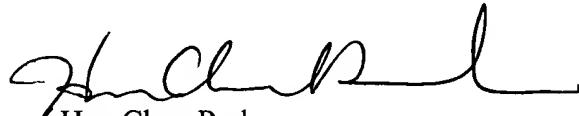
CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



Hae-Chan Park
Reg. No. 50,114

Date: November 30, 2004

McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
McLean, VA 22102-4215
Tel: 703-712-5365
Fax: 703-712-5280
HCP:PCF